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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/562,409	09/08/2006	Michiel Arjaan Kousemaker	KOUSEMAKER ET AL- IPCT	6090

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EXAMINER	
PO, MING CHEUNG	
ART UNIT	PAPER NUMBER
1797	
MAIL DATE	DELIVERY MODE
06/02/2010	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action Before the Filing of an Appeal Brief	Application No.	Applicant(s)	
	10/562,409	KOUSEMAKER ET AL.	
	Examiner	Art Unit	
	MING CHEUNG PO	1797	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 17 May 2010 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

   a) ☒ The period for reply expires *3* months from the mailing date of the final rejection.

   b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

   Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
   (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
   (b) ☐ They raise the issue of new matter (see NOTE below);
   (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☒ Applicant's reply has overcome the following rejection(s): Claims 5-7 rejected under 35 U.S. C. 112 second paragraph .

6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
   The status of the claim(s) is (or will be) as follows:
   Claim(s) allowed: _____.
   Claim(s) objected to: _____.
   Claim(s) rejected: *1,3,4 and 8-14*.
   Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.

12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____

13. ☒ Other: See Continuation Sheet.

/Ming Cheung Po/

/ELLEN MCAVOY/
Primary Examiner
Art Unit 1797

Continuation of 13. Other: Applicant argues that examiner is wrong in the assertion that it would be obvious to one of ordinary skill in the art that 2,2-dimethyl-4-hydroxylmethyl-1,3-dioxolan would react with i- butene to form ethers. Examiner disagrees. Applicant further argues that the process and resultant product that is taught by WESSENDORF is different from the presently claimed invention. WESSENDORF teaches 2,2-dimethyl-4-tert-butoxymethyl-1,3-dioxolan which is 2,2-dimethyl-4-hydroxymethyl-1,3-dioxolan after it has its own hydroxyl group etherified by i-butene. One of ordinary skill in the art given the starting reactants that WESSENDORF teaches and the products would know this.

Applicant argues that the process and resultant product is different from the presently claimed invention because the acetone and i-butene are present at the same time with the glycerin and compete for reaction instead of allowing the acetone to form an acetal first and then allowing the i-butene to etherify the hydroxyl groups. WESSENDORF does not teach which compound reacts with the glycerin first but there is no reason to believe that the reference pathway only produces the product via etherification and then acetalization especially because of WESSENDORF teaches the presence of 2,2-dimethyl-4-tert-butoxymethyl-1,3-dioxolan which has been acetalized but not etherified. Furthermore, selection of any order of performing process steps is prima facie obvious in the absence of new or unexpected results. In re Burhans, 154 F.2d 690, 69 USPQ 330 (CCPA 1946) Selection of any order of mixing ingredients is prima facie obvious. In re Gibson, 39 F.2d 975, 5 USPQ 230 (CCPA 1930) . See MPEP 2144.04 IV. C.

Applicant argues that the method that WESSENDORF teaches produces a number of different reaction products, a large number of which contain unreacted hydroxyl groups. Applicants further state that Examiner has not addressed this point. Examiner disagrees. As noted by applicant, examiner stated that it would be obvious to one of ordinary skill in the art to purify a compound to more than 95% pure by separating out other compounds. Examiner also noted that purity of 95% is only referenced in claim 12. If applicant is suggesting that the claims exclude the different reaction products, it is not reflected in the claims. Examiner has stated that although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See In re Van Geuns, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant argues that the presently claimed method can achieve a purity of more than 95% without having to be purified. Applicant further argues that because WESSENDORF is silent to particle emission, it would not have been obvious to one of ordinary skill in the art to purify the compound. Examiner disagrees. WESSENDORF teaches on line 4 of page 4 of the machine translation that the examples are directed toward the production of GTBE. It would be obvious to one of ordinary skill in the art to separate out GTBE from the other components and in example 4, the separation of GTBE would leave 30.2 % teaches 2,2-dimethyl-4-tert-butoxymethyl-1,3-dioxolan in a total of 31.47% which equates to about 95%. The fact that WESSENDORF does not teach the reason for purification is due to particle emissions does not change the fact that a purity of 95% of 2,2-dimethyl-4-tert-butoxymethyl-1,3-dioxolan may be reached..